

REMARKS

Claims 1-22 are pending in the present application.

In the office action mailed September 27, 2005 (the “Office Action”), claims 1-22 were rejected under 35 U.S.C. 102(b) as being anticipated by applicant’s admitted prior art (the “AAPA”).

The Examiner’s rejection of claims 1-22 as being anticipated by the AAPA is based on the argument that “phrases such as ‘adapted to’ and ‘operable’ are functional language which bears no patentable weight.” *See* the Office Action at page 2. The Examiner further cites *In re Hutchinson*, 154 F.2d 135, 69 U.S.P.Q. 138 (C.C.P.A. 1946) supporting the proposition that “recitation that an element is ‘adapted to’ perform a function is not a positive limitation but only requires the ability to so perform.” *See* the Office Action at page 2.

The holding of *In re Hutchinson* is inapplicable to the present claims. As noted by the court in *In re Hutchinson*, the term “adapted” is used in the *introductory* clause of the claims at issue. In contrast, the word “adapted” in the pending claims is found in the *body* of the claim separated from the preamble by a transitional phrase, such as “comprising” or “including,” and is used to recite functional limitations for particular elements. For example, claim 1 recites a row driver comprising a circuit *adapted* to receive an input signal and a test mode signal, and *adapted* to be coupled to first and second voltage sources and having an output adapted to be coupled to a word line. Claim 7 recites a row driver, comprising an isolation circuit *adapted* to receive a reference voltage and a test mode signal.

The word “adapted” has been interpreted by to mean “capable.” *See R.A.C.C. Indus., Inc. v. Stun-Tech, Inc.*, 49 U.S.P.Q.2d 1793 (Fed. Cir. 1998). As held by the court in *R.A.C.C.*, functional language set forth by “adapted” limits the scope of the claims to devices that have the *capability* defined by the functional language. *See R.A.C.C.*, 49 U.S.P.Q.2d at 1796-97. More generally, the court in *R.A.C.C.* stated that, “an apparatus claim may include function limitations,” and that “functional language in an apparatus claim [is interpreted] as requiring that an accused apparatus possess the capability of performing the recited function.” *See id.* (citing *Intel Corp. v. U.S. Int’l Trade Comm’n*, 948 F.2d 821, 832 (Fed. Cir. 1991)). The general philosophy of providing patentable weight to functional language endorsed by the court in *R.A.C.C.* can be applied to the word “operable” as well. That is, functional language following

the word “operable” provides patentable weight by limiting an element to possessing the capability of performing the function.

Moreover, although the Examiner takes issue with the use of “operable,” numerous U.S. patents have claims using “operable” to describe functional aspects of a device. For example, U.S. Patent No. 6,963,512 having claims directed to a memory comprising a comparator *operable* to compare the respective contents of each memory cell in one of the columns with a respective test value from the pattern generator and U.S. Patent No. 6,963,499 having claims directed to a memory comprising a first switch circuit *operable* to receive a mode signal and to provide the mode signal after a first propagation delay. Both the ‘512 and ‘499 patents issued this past Tuesday, November 8, 2005. The Examiner in the present application has also allowed claims that use the word “operable” to define a functional limitation. For example, U.S. Patent No. 6,597,629 including claims directed to a self-referenced timing system having a built-in shutdown mechanism for memory access operations comprising wordline control circuitry *operable* to generate a wordline start (WLS) signal and U.S. Patent No. 6,496,439 including claims directed to a content addressable memory (CAM) integrated circuit chip comprising a voltage supply circuit *operable* to compare an external voltage applied to the off-chip voltage input to a supply reference voltage and, in response to a drop in the external voltage below the supply reference voltage, switch the second power supply input for the CAM array from the external voltage input to the back-up battery.

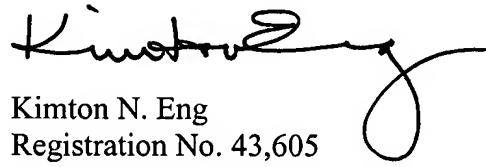
Thus, use of words such as “adapted” and “operable” to define functional limitations is generally accepted. With respect to the pending claims, the functional limitations recited by the claims should be given proper patentable weight by the Examiner in examining the claims. When done so, the AAPA fails to disclose the combination of limitations recited by the respective claims.

For the foregoing reasons, claims 1-22 are patentably distinct from the AAPA, and therefore, the rejection of claims 1-22 under 35 U.S.C. 102(b) should be withdrawn.

All of the claims pending in the present application are in condition for allowance.
Favorable consideration and a timely Notice of Allowance are earnestly solicited.

Respectfully submitted,

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